

### REMARKS

Applicants have amended certain claims to more particularly point out their invention.<sup>1</sup> Applicants also attach an Expert Declaration demonstrating why the claim limitations quoted at page 4 of the Office Action do not add "new matter" but rather are fully supported by applicants' disclosure. Applicants also attach a Terminal Disclaimer to obviate the obviousness-type double patenting rejection. Applicants request the Examiner to reconsider and allow this patent application in view of the claim amendments and the following remarks and the attachments hereto.

### Interview Summary

As an initial matter, applicants appreciate the time and attention that Examiner Vo devoted to the 6/19/01 personal interview. During the interview, Mr. Faris explained that applicants had filed the subject continuing application primarily in order to unequivocally establish that they are entitled to a 4/9/97 or 2/22/95 effective filing date for the claims pending herein.<sup>2</sup>

Per the guidance given by Examiner Vo during the interview, applicants have decided to handle the continuing data/ priority claim under 35 USC §120 issue by amending their specification to state that this application is a "continuing" application which claims priority under 35 USC §120. As Mr. Faris explained during the interview,

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<sup>1</sup> Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page/s is/are captioned "version with markings to show changes made."

<sup>2</sup> Mr. Faris explained that U.S. Patent No. 5,898,455 to Barakat et al. (of record) claims the benefit of provisional application serial no. 60/068,589 (also of record) filed 12/23/97. Applicants wish to unequivocally establish that their effective filing date predates 12/23/97.

the subject specification claims priority under 35 USC§120 from copending application Serial No. 09/001,484 and through that application to other prior applications including application Serial No. 08/838,677 filed 4/9/97 -- to which it is identical. Immediate parent application Serial No. 09/001,484 is a slightly expanded version of Serial No. 08/838,677 in that it contains all of the disclosure of Serial No. 09/001,484 plus some additional disclosure (i.e., parent application Serial No. 09/001,484 is a "continuation-in-part" of application Serial No. 08/838,677).

As discussed during the interview, since the subject specification actually contains less disclosure than parent application Serial No. 09/001,484, it does not add any "new matter" vis-à-vis the parent application -- and it would therefore be improper to call this application a "continuation in part". See MPEP 201.08 ("A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application ... and *adding matter not disclosed* in the said earlier nonprovisional application [citations omitted].") However, this application is also not identical to immediate parent application Serial No. 09/001,464. To avoid the possibility of applying labels that may later be misconstrued, applicants have amended their specification to change the term "continuation" to "continuing". This amendment should remove the objection to the disclosure at page 2 of the Office Action while still perfecting applicants' right to claim priority under 35 USC §120 back to their 4/9/97 and 2/22/95 filings.

Mr. Faris and Mr. Vo also discussed whether the subject specification adequately supports the claim limitations directed to conversion of a block of plural television

program signals/channels. Mr. Faris gave reasons why the specification does indeed provide such an adequate disclosure (e.g., the specification discloses a low-noise block converter that outputs blocks of channels received from the satellite, and the rest of the disclosed exemplary converters and the satellite receiver on the other end of the distribution system further process these received channel blocks).

After the interview, Mr. Faris contacted Randy Bell, an RF engineer with nearly 25 years of experience in designing various radio equipment including satellite receivers and cable television distribution systems, and asked for his opinion on this issue. Mr. Bell's opinion, which is set forth in the attached Expert Declaration, confirms that the subject specification does "provide adequate such description and would have conveyed, to an artisan ordinarily skilled in the art, that the disclosed exemplary converters are each block converters that convert blocks of multiple channels received from a satellite." Bell Declaration at para. 2.<sup>3</sup> Mr. Bell gives several reasons for his opinion, including the following:

- "[D]isclosed exemplary converters 28 and 30 each receive a block of multiple received satellite channels from the low-noise block converter 24" (para. 4);
- "[T]he 'Description of The Preferred Embodiments' section ... describes these converters as operating to 'convert the signals of one polarity up (via converter 30) and to convert the signals of second polarity down (via converter 28)' with the

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<sup>3</sup> At least some claims herein are believed to be entitled to an effective date of 2/22/95 because they are supported by applicants' application Serial No. 08/394,234. See "Expert Declaration of Randy Bell" filed in

“signals” being “blocks of multiple channels outputted by the low-noise block converter 24 to the converters 28, 30.” (para. 5);

- “[T]he ‘Description of the Preferred Embodiments’ section does not say that converters 28, 30 select particular channels from the low-noise block converter output for application to cable 16a” (para. 5);
- “[T]he ‘Description of The Preferred Embodiments’ section ... states that exemplary converters 52, 54, 58 essentially reverse the process of the head-in processor so that the ‘reconverted signals, frequencies and polarities in its original state, is transmitted to the satellite receiver 21 via lines 22a and 22b’” (para. 6); and
- “[I]t would also have been readily apparent to someone skilled in the art ... that exemplary converters 52, 54, 58 output blocks of multiple channels to the disclosed satellite receiver 21” (para. 7).

Mr. Bell’s declaration makes it clear that applicant’s specification has an adequate written description for the claims now pending. *See e.g., Vas-Cath v. Mahurkar*, 935 F.2d 1555, 1560-64 and especially 1563 (Fed. Cir. 1991) (“the test for sufficiency of support in a parent application is whether the disclosure of the application relied on reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter [citations omitted]”).

In view of Mr. Bell’s opinion, there can be no doubt that the specification provides adequate support for the amended claim 1 limitations “the first frequency converter

converting at least the first block comprising the first plurality of television program signals”, “a second plurality of television program signals”, “the second frequency converter further converting said converted first block comprising the first plurality of television program signals”, and “wherein all of the television program signals within the first block comprising the first plurality of television program signals are received by the satellite dish with a common polarization.”<sup>4</sup> Similarly, the Bell declaration makes it clear that the specification adequately supports the claim 7 limitations “block converter that frequency-converts a channel block”, “said switch operating to select between said frequency-converted channel block and at least one further channel block.”<sup>5</sup>

Claims 7-12 are not subject to any art rejection, but claim 1 has been rejected as “obvious” in view of Uemura. Applicants have, without prejudice or disclaimer, amended claim 1 to more particularly point out the invention by requiring the conversion to be applied to received blocks of plural television program signals. As discussed during the interview, this “block conversion” feature fully distinguishes the invention over the applied Uemura reference. Uemura teaches “extracting a signal of the desired channel” for application to the cable (see e.g., page 3 of Uemura translation and Figure 4 and associated text). Uemura thus teaches away from a television signal distribution system

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Serial No. 08/394,234 filed 2/22/95, from which the subject application also claims priority.

<sup>4</sup> By this last quote, applicants refer to the feature of the disclosed exemplary embodiment that received multi-channel signal blocks are received by satellite dish 12 with either a vertical polarization or a horizontal polarization. See e.g., specification at page 14, lines 1-4 and Bell Declaration para. 5.

<sup>5</sup> See also specification at page 19, lines 20-22 (“In this embodiment, the switch 60 is used to determine which polarity will enter into the head-out processor 18b.”)



that stacks frequency-converted blocks of channels received from the satellite onto a distribution cable.

**Other Remaining Issues**

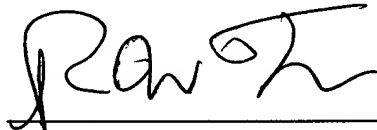
Applicants have amended claim 7 to change "plurality" to "polarity" as the Examiner suggested. Applicants also attach a Terminal Disclaimer which obviates the "obviousness-type" double patenting rejection.

All outstanding issues have been addressed and this application is in condition for allowance. Should any minor issues remain outstanding, the Examiner should contact the undersigned at the telephone number listed below so they can be resolved expeditiously without need of a further written action.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



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